Supreme Court, U.S
FILED
NOV 8 1994
OFFICE OF THE CLERK

No. 93-1577

IN THE
SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1994

QUALITEX COMPANY,

Petitioner,

v.

JACOBSON PRODUCTS CO., INC.,

Respondent.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

BRIEF AMICUS CURIAE FOR THE BAR ASSOCIATION OF THE DISTRICT OF COLUMBIA IN SUPPORT OF REVERSAL

Bruce T. Wieder
Counsel of Record
Chair, Amicus Committee
Teresa Stanek Rea, Chair
Patent, Trademark & Copyright Section
Bar Association of the District of Columbia
1819 H Street, N.W., 12th Floor
Washington, D. C. 20006
(202) 223-6600

Of Counsel:
Sheldon H. Klein
Linda S. Paine-Powell
Jeffrey M. Samuels

BEST AVAILABLE COPY

TABLE OF CONTENTS

		Page
I.	AUTHORITY TO FILE	1
II.	INTEREST OF AMICUS	1
III.	QUESTION PRESENTED	1
IV.	SUMMARY OF ARGUMENT	2
V.	ARGUMENT	2
	A. *PER SE* RULES ARE INAPPROPRIATE FOR THE FACT-BASED ANALYSIS REQUIRED TO DETERMINE WHETHER A MARK IS PROTECTABLE	2
	B. THE LANHAM ACT DOES NOT PROHIBIT THE REGISTRATION OF SINGLE COLOR MARKS	5
VI.	CONCLUSION	9

Page

CASES:

Boston Beer Co. v. Slesar Bros. Brewing Co., 9 F.3d 175 (1st Cir. 1993) 3

Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc., 467 U.S. 837 (1984) 5

Clifton Mfg. Co. v. Crawford-Austin Mfg. Co., 12 S.W.2d 1098 (Tex. Civ. App. 1929) 3

Deere & Co. v. Farmhand, Inc., 560 F. Supp. 85 (S.D. Iowa 1982) 3

In re E.I. du Pont de Nemours & Co., 476 F.2d 1357 (C.C.P.A. 1973) 7

Master Distribs. Inc. v. Pako Corp., 986 F.2d 219 (8th Cir. 1993) 3, 7

NutraSweet Co. v. Stadt Corp., 917 F.2d 1024 (7th Cir. 1990) 4

Olay Co. v. Cococare Prods., Inc., 218 U.S.P.Q. 1028 (S.D.N.Y. 1983) 3

In re Owens-Corning Fiberglas Corp., 774 F.2d 1116 (Fed. Cir. 1985) 3-5, 7, 8

Qualitex Co. v. Jacobson Prods. Co., 13 F.3d 1297 (9th Cir.) 2, 4, 5

Sylvania Elec. Prods., Inc. v. Dura Elec. Lamp Co., 247 F.2d 730 (3d Cir. 1957) 3

Textron, Inc. v. United States Int'l Trade Comm'n, 753 F.2d 1019 (Fed. Cir. 1985) 3

United States v. Topco Assocs., Inc., 405 U.S. 596 (1972) . . 4

In re Yarn Processing Patent Validity Litig., 541 F.2d 1127 (5th Cir. 1976) 4

Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co., 147 F.2d 407 (6th Cir. 1945) 3

STATUTES:

15 U.S.C. § 1051 2

15 U.S.C. § 1052 . . . . . 6, 7

15 U.S.C. § 1127 6

OTHER AUTHORITIES:

Lawrence B. Ebert, *Trademark Protection in Color: Do It by the Numbers!*, 84 Trademark Rep. 379 (1994) 8

1 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 7.06 (3d ed. 1994) 3

Jeffrey M. Samuels & Linda B. Samuels, *Color Trademarks: Shades of Confusion*, 83 Trademark Rep. 554 (1993) 8

S. Rep. No. 100-515, 100th Cong., 2d Sess. 44 (1988) 7

I. AUTHORITY TO FILE

This brief *amicus curiae* is presented by the Bar Association of the District of Columbia under Rule 37.3 of this Court. Letters of consent from the parties are filed herewith.

II. INTEREST OF AMICUS

The Bar Association of the District of Columbia is a voluntary nonprofit membership organization. Membership is not restricted to any segment of the profession and thus the members and their clients represent widely diverging interests and views. Members include attorneys in private practice as well as those employed by corporations and those in government.

The Patent, Trademark & Copyright Section of the Bar Association of the District of Columbia includes members of the bar regularly practicing in and interested in trademark law. Members frequently represent trademark owners and accused infringers and are thus concerned both with the enforcement of trademarks and with the defense against trademark infringement actions.

In this brief, the Bar Association of the District of Columbia seeks to persuade this Honorable Court that the Lanham Act does not prohibit the registration of color alone as a trademark.

III. QUESTION PRESENTED

Whether the Lanham Act prohibits the registration of color as a trademark.

IV. SUMMARY OF ARGUMENT

The Lanham Act, 15 U.S.C. § 1051, et seq. (1988 & Supp. V 1993), does not prohibit the registration of color as a trademark and a *per se* rule against the registrability of color is both unnecessary and inappropriate. Courts engaging in the factual analysis required to determine whether something is protectable as a trademark have protected single color marks in some fact situations. Thus, a *per se* rule banning protection for single color marks via federal registration is inappropriate.

The Lanham Act uses inclusive language, making registration available to any mark, with certain enumerated exceptions, that is "distinctive of the applicant's goods in commerce." The Act does not exclude color from registration as a trademark. Rather, the Act prohibits *denial* of registration to any mark on account of its nature.

The Ninth Circuit's holding in *Qualitex Co. v. Jacobson Prods. Co.*, 13 F.3d 1297 (9th Cir.), *cert. granted*, 115 S. Ct. 40 (1994), that color *per se* should not be registrable as a trademark, is at odds with the fundamental nature of the analysis required in trademark matters and is at odds with the Lanham Act itself. The Ninth Circuit's determination should be reversed.

V. ARGUMENT

A. *PER SE* RULES ARE INAPPROPRIATE FOR THE FACT-BASED ANALYSIS REQUIRED TO DETERMINE WHETHER A MARK IS PROTECTABLE

The standards for determining whether a mark is protectable as a trademark are well settled. Included in a court's analysis is

an examination of whether a mark is distinctive, *i.e.*, whether the mark is inherently distinctive, is descriptive of the goods, or is generic for the goods, *Boston Beer Co. v. Slesar Bros. Brewing Co.*, 9 F.3d 175, 180 (1st Cir. 1993); whether, if found to be descriptive, it has acquired distinctiveness, *Id.*; whether it consists of a legally functional aspect of the goods, *Textron, Inc. v. United States Int'l Trade Comm'n*, 753 F.2d 1019, 1025 (Fed. Cir. 1985); and whether it functions as a trademark, *see, e.g.*, 1 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 7.06 (3d ed. 1994). Courts have used these factual standards to evaluate single color marks in a variety of circumstances and have already demonstrated that evaluation of single color marks is amenable to these standards. Moreover, the results of the application of these standards fall into no predictable pattern.

Some courts have stated that under certain fact situations, color alone is protectable as a trademark. *E.g.*, *In re Owens-Corning Fiberglas Corp.*, 774 F.2d 1116 (Fed. Cir. 1985) (pink for fiberglass insulation); *Master Distribs. Inc. v. Pako Corp.*, 986 F.2d 219 (8th Cir. 1993) (blue for leader splicing tape); *Yellow Cab Transit Co. v. Louisville Taxicab & Transfer Co.*, 147 F.2d 407 (6th Cir. 1945) (yellow for taxi cabs); *Clifton Mfg. Co. v. Crawford-Austin Mfg. Co.*, 12 S.W.2d 1098 (Tex. Civ. App. 1929) (reddish brown for tents, tarpaulins, and wagon covers). Other courts have found facts supporting denial of protection of a single color mark. *E.g.*, *Olay Co. v. Cococare Prods., Inc.*, 218 U.S.P.Q. 1028 (S.D.N.Y. 1983) (pink for beauty lotion had not acquired a secondary meaning); *Deere & Co. v. Farmhand, Inc.*, 560 F. Supp. 85, 96-98 (S.D. Iowa 1982) (protection of green farm equipment would hinder competition), *aff'd*, 721 F.2d 253 (8th Cir. 1983) (per curiam); *Sylvania Elec. Prods., Inc. v. Dura Elec. Lamp Co.*, 247 F.2d 730 (3d Cir. 1957) (blue dot on flashbulb not valid trademark because it was functional). These cases demonstrate that whether or not a single color mark will pass muster as a trademark depends on the circumstances of the particular case. In light of this factual

dependency, a *per se* rule against single color marks is inappropriate.

Per se rules are appropriate where the presence of a particular factor or factors leads to a predictable result regardless of the other factors present. *United States v. Topco Assocs., Inc.*, 405 U.S. 596, 607 (1972); *see also In re Yarn Processing Patent Validity Litig.*, 541 F.2d 1127, 1134 (5th Cir. 1976), *cert. denied*, 433 U.S. 910 (1977). Courts, however, have not found single color marks to be predictably unprotectable.

The Seventh Circuit's stated desire to avoid a review of marketplace factors and its explicit refusal to adopt a fact-driven standard, *NutraSweet Co. v. Stadt Corp.*, 917 F.2d 1024, 1028 (7th Cir. 1990), *cert. denied*, 499 U.S. 983 (1991), and the Ninth Circuit's implied concurrence with this position, *Qualitex*, 13 F.3d at 1302, are without foundation in trademark law. The decision of whether *any* type of mark functions as, or is protectable as, a trademark depends heavily on the particular facts associated with the mark. That the claimed trademark is a color should not change this analysis.

Two reasons frequently cited as bases for application of a *per se* rule against protection of color as a trademark are color depletion and shade confusion. However, these concerns do not arise consistently and thus are insufficient to support the creation of a *per se* rule against single color marks. Even in the present case, the Ninth Circuit found color depletion not to be of concern. *Qualitex*, 13 F.3d at 1302. And the issue of shade confusion is no different than the issue of confusion of word marks frequently addressed by the courts, *see Owens-Corning*, 774 F.2d at 1123. Thus, neither concern provides a basis for a *per se* rule.

A *per se* ban on the protection of single color marks will foreclose protection to those marks that would survive a full,

fact-driven examination. Worse, to disallow trademark protection in those instances where a single color functions as a trademark may increase rather than diminish consumer confusion — contrary to one of the basic purposes of trademark law, *see Owens-Corning*, 774 F.2d at 1119 (discussing the Lanham Act). When the overall color of a product has acquired such distinctiveness that consumers rely upon it as a trademark, then others should be prevented from appropriating that color mark in order to protect those consumers. A *per se* rule would foreclose this possibility.

B. The Lanham Act does not Prohibit the Registration of Single Color Marks

The Ninth Circuit forgoes reliance upon enacted law in its decision in *Qualitex* and instead engages, inappropriately, in a legislative/policy choice. The Ninth Circuit rationalized that single color marks should not be registered, because "[a]dequate protection is available when color is combined in distinctive patterns or designs or combined in distinctive logos." *Qualitex*, 13 F.3d at 1302. But it is the province of the legislature, not the judiciary, to determine what is adequate protection. And in the Lanham Act the plain meaning of the statute is clear and, therefore, conclusive. *See Chevron, U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 842-43 (1984).

The Act defines a "trademark" broadly, without boundaries as to species of marks:

> any word, name, symbol, or device or any combination thereof . . . used by a person . . . to identify and distinguish [that person's] goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

Lanham Act, § 45, 15 U.S.C. § 1127. Under the statute, the defining characteristic of a trademark is its ability "to identify and distinguish." *Id.* Color, in whatever form, falls within this definition, so long as it identifies and distinguishes one person's goods from those of another.

The criteria for registration set forth in Section 2 of the Act also does not exclude color as a trademark:

> No trade-mark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register *on account of its nature* unless it [consists of immoral, deceptive, or scandalous matter; an insignia of the United States, a state, or a municipality; a name, portrait, or signature of a living individual; or a mark which is impermissibly descriptive].

Lanham Act, § 2, 15 U.S.C. § 1052 (emphasis added). Not only is there no restriction on the type of mark which is registrable, outside of the narrow, noncolor-related exceptions set forth in the Act, but Section 2 explicitly states that no trademark shall be refused registration *on account of its nature*. Thus, a mark is not to be refused registration on the basis that, by its "nature," it consists of a single color.

The final subsection of Section 2 of the Act requires the registration of any mark not specifically excluded by the prior subsections, if such mark has become distinctive of the goods or services:

> except as expressly excluded in . . . this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce.

Lanham Act, § 2(f), 15 U.S.C. § 1052(f). Thus, the Act is inclusive, not exclusive. Anything can qualify for trademark protection, so long as that thing is capable of functioning as a trademark according to the requirements of distinctiveness (and other statutory requirements). The Act rewards competitive efforts to develop a distinguishing mark, whatever that mark may be. A person who succeeds in developing an identifying symbol obtains protection for that symbol as a trademark. Therefore, so long as an asserted color mark functions as a trademark, the Act forbids denial of its registration.

Moreover, the legislative history of the Lanham Act supports such an inclusive interpretation of the Act. As enacted in 1946, Congress intended the Lanham Act to expand the protection of trademarks:

> The legislative history of the Act as a whole describes its objective as making registration "more liberal," dispensing with "mere technical prohibitions and arbitrary provisions" and modernizing the trademark statutes "so that they will conform to legitimate present-day business practice."

Owens-Corning, 774 F.2d at 1119 (quoting *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1360 (C.C.P.A. 1973)). The legislative history of the extensive 1988 amendments to the Act include a specific endorsement of color as a trademark. In 1988, Congress changed the definition of a trademark in Section 45 of the Lanham Act, but only to alter the requirements for use. It "intentionally retain[ed] . . . the words 'symbol or device' *so as not to preclude the registration of colors*, shapes, sounds or configurations where they function as trademarks." S. Rep. No. 100-515, 100th Cong., 2d Sess. 44 (1988), *reprinted in* 1988 U.S.C.C.A.N. 5577, 5607 (emphasis added) and quoted in *Master Distribs.*, 986 F.2d at 224. Thus, despite having before it the issue of the registrability of color, and despite the pre-existence of

Owens-Corning upholding protection of a single color mark (pink for fiberglass insulation) and the extensive attention given to that case,[1] Congress specifically chose not to exclude color as a type of trademark available for registration.

In keeping with the breadth of the definition of a mark, the Patent and Trademark Office has registered a wide variety of somewhat unconventional trademarks, including

> the shape of a household cleaner bottle, the triangular shape of a chemical, a wine bottle, the sound of the Liberty Bell ringing, the sound of a creaking door, the musical notes GEC, a stylized key logo as a jewelry design, and the fragrance of Plumeria blossoms as applied to sewing thread and embroidery yarn.

Lawrence B. Ebert, *Trademark Protection in Color: Do It by the Numbers!*, 84 Trademark Rep. 379, 382 (1994) (citations omitted).

Under the statute, anything capable of distinguishing a product or service qualifies for registration. The statutory restrictions on what is and is not a registrable trademark focus not on type, but on the capacity of a particular claimed mark to distinguish one entity's goods or services from those of another, and to function as an indication of the source of those goods or services. A prohibition on the registrability of color is without basis under the Lanham Act.

---

[1] *See* Jeffrey M. Samuels & Linda B. Samuels, *Color Trademarks: Shades of Confusion*, 83 Trademark Rep. 554, 559 (1993), citing four articles favorably discussing *Owens-Corning*, each of which was published in 1986, and thus prior to the 1988 amendments to the Lanham Act.

VI. CONCLUSION

A *per se* rule prohibiting the registrability of color as a trademark is inappropriate since a fact-based analysis may reveal that a single color does function as a trademark and, therefore, qualifies for protection as a trademark. Moreover, the inclusive language of the Lanham Act does not exclude the registrability of color.

Therefore, the Ninth Circuit's determination that color *per se* should not be registrable as a trademark should be reversed.

Respectfully submitted,

Bruce T. Wieder
Counsel of Record
Chair, Amicus Committee
Teresa Stanek Rea, Chair
Patent, Trademark & Copyright Section
Bar Association of the District of Columbia
1819 H Street, N.W., 12th Floor
Washington, D. C. 20006
(202) 223-6600

Of Counsel:

Sheldon H. Klein
Linda S. Paine-Powell
Jeffrey M. Samuels